

REMARKS

1) The Examiner has rejected claims 1, 2, 3, and 20 under 35 U.S.C. 102 over JP 2003-135970 (hereinafter JP '970). Applicants respectfully assert that this ground of rejection has been overcome by the instant amendment.

The present invention relates to a catalyst for treating diesel exhaust gas. In particular, it claims a combustion catalyst for treating a suspended particulate matter in a diesel exhaust gas, wherein said combustion catalyst comprises: a carrier consisting of a *ceria-praseodymium oxide-lanthanum oxide*; and a precious metal or an oxide thereof as a catalytic component loaded on the carrier.

JP '970 relates to exhaust gas catalysts. In particular, it describes a carrier composition which includes ceria, lanthanum, and certain other optional materials. However, Applicants submit that the JP '970 fails to disclose the *exact* carrier materials of the presently amended claims. Specifically, JP '970 fails to teach a carrier composition *consisting of* ceria -praseodymium oxide-lanthanum oxide, as presently required. As shown in Table 1 of JP '970, their only embodiments which include praseodymium in their carrier compositions also require the presence of *barium oxide*. Applicants urge that due to the "consisting of" language of the presently amended claims, barium oxide is effectively *excluded* from the carrier materials of the claimed invention. As stated in MPEP §2111.03, the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). Therefore, no other materials may exist in the presently claimed carriers except for a ceria-praseodymium oxide-lanthanum oxide. Thus, JP '970's inclusion of barium oxide expressly differs and teaches away from the carrier compositions of the presently claimed invention. For these reasons, Applicants respectfully submit that the present invention is patentably distinct from JP '970, and the 35 U.S.C.102 rejection has been overcome.

2) The Examiner has rejected claims 5-17 under 35 U.S.C. 103 over JP 2003-135970 (hereinafter JP '970) in view of Silver (US 6,455,182) and Marecot et al. (US 5,413,984). Applicants respectfully urge that this ground of rejection has been overcome by the instant amendment.

The arguments against JP '970 are repeated from above and apply equally here. Specifically, all embodiments of JP '970 which include lanthanum, ceria, and praseodymium in their carrier composition *further* require the presence of barium oxide. However, the language of the presently amended claims effectively *excludes* barium oxide, or any other material, from the inventive carrier compositions except for ceria-praseodymium oxide-lanthanum oxide.

The Examiner next cites Silver for teaching the use of a ceria oxide and a supported noble metal. However, it is urged that this reference still fails to overcome the deficiencies of JP '970. First, nowhere does Silver teach or suggest a carrier composition which include oxides of both praseodymium *and* lanthanum. Rather, this reference discloses a tertiary combination of ceria, zirconia, and *a third metal oxide* which is one of praseodymium oxide, lanthanum oxide, neodymium oxide, or hafnium oxide, to form a ternary mix of the metal oxides (see col.2 line 65 through col.3 line 3). None Silver's embodiments teach or suggest the inclusion of *both* praseodymium oxide and lanthanum oxide in their carrier compositions, as presently required. Furthermore, since Silver specifically relates to a *tertiary* combination which must already contain ceria and zirconia as two of its three components, it is urged that the carrier composition of Silver could not possibly contain both praseodymium oxide *and* lanthanum oxide, as presently required. In addition, while zirconia is a required component of Silver's carrier compositions, the presently amended claim 1 effectively *excludes* zirconia from the inventive carrier compositions. Again, the present claims state that the inventive catalyst carrier consists of a ceria-praseodymium oxide-lanthanum oxide. All other materials are excluded therefrom. Thus, whether or not certain precious metals are taught by Silver, this reference still fails to cure the defects of JP '970, and fails to obviate the present claims.

Next, Marecot is cited for teaching the use of multiple catalyst metals. However, Applicants further submit that Marecot still does not fill the voids of JP '970 and Silver. That is, whether or not Marecot teaches multi-metal catalysts, it still does not add anything to the cited art which would be sufficient to obviate the specific makeup of the presently claimed carrier composition which *consists of* ceria-praseodymium oxide-lanthanum oxide. Silver still requires both ceria and zirconia. Thus, a combination of Silver's materials with the addition of Marecot's multi-metal catalysts would still have to include ceria, zirconia, and praseodymia, in direct contrast to the presently claimed carriers. As stated above, zirconia is effectively excluded by the language of the presently amended claims. In addition, Marecot also fails to teach carriers which include both praseodymium *and* lanthanum. Thus, it is urged that even a hypothetical combining of JP '970, Silver, and Marecot would still fail to obviate the presently claimed invention.

In addition, it is submitted that all of claims 5-17 depend from claim 1, which has not been rejected under 35 U.S.C. 103 over a combination of JP '970, Silver, and Marecot. It is submitted that while certain individual additional features of these claims may be otherwise known in the art, these claims all relate to *narrower* embodiments of the invention disclosed in claim 1. Applicants therefore submit that where claim 1 is sufficiently inventive in view of the cited art for the reasons argued above, all claims depending therefrom should be considered inventive as well. For all of the above reasons, it is respectfully urged that the 35 U.S.C. 103 rejection should be withdrawn.

The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the Examiner believes there is any matter which prevents allowance of the present application, it is requested that the

undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



Marisa A. Roberts
Marisa A. Roberts
Reg. No. 43,048
P.O. Box 484
Princeton, New Jersey 08542
(609) 921-3500
Date: March 11, 2010